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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,046	02/13/2004	Matthew Lerner	003797.00739	3923

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BANNER & WITCOFF LTD.,
ATTORNEYS FOR CLIENT NOS. 003797 & 013797
1001 G STREET, N.W.
SUITE 1100
WASHINGTON, DC 20001-4597

EXAMINER

TSUI, WILSON W

ART UNIT PAPER NUMBER

2178

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/777,046	Applicant(s) LERNER ET AL.	
	Examiner Wilson Tsui	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 5-7, 9, 10, 13, 15, 16, 19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 5-7, 9, 10, 13, 15, 16-19, and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on: 7/5/2006 for the application filed on: 2/13/2004
2. In the amendments claims 2, 5-7, 9, 10, 13, 15, 16, and 19 have been amended and claims 1, 3-4, 8, 11-12, 14, 17-18, and 20 have been cancelled. New claims 21-26 have been added, and thus, claims 2, 5-7, 9, 10, 13, 15, 16, 19, 21-26 are pending in the application. Claims 9, 23, 13, 15, 19, and 21 are independent claims.
3. The objection to the abstract has been withdrawn, as well as the objection to the Title of the invention.
4. The previous rejections for claims 2, 5-7, 9, 10, 13, 15, 16 and 19 have been withdrawn in light of new grounds of rejections necessitated by the amendments.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 6, the claim recites "according to claim 6a, wherein said documents are from different application programs". However, there is no claim "6a", and assuming "6a" was a typo, and it was supposed to be "6", the claim is then referring back unto itself, which doesn't particularly refer to any different criteria. Additionally in

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the same line that was recited, the applicant claims "said documents" (page 7, line 3 of the claim), there is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 5-7, 9, 10, 13, 15, 16, 19, 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Madduri (US Patent: 6,551,357 B1, issued: Apr. 22, 2003, filed: Feb. 12, 1999).

With regards to claim 23, Madduri teaches a system comprising:

- *An input for receiving annotations associated with content* (column 4, lines 30-42: whereas, a user inputs markings to a document), for which the markings are associated with content (column 1, lines 29-34).
- *A processor for creating a renderable image having clips* (column 4: lines 43-63: whereas, a renderable image comprising clips is generated/created), *wherein at least one of said clips is a combination of two or more annotations* (column 8, lines 14-28: whereas, the image can contain a clip that is a combination of two or more markings/annotations, such as explained where a marking/annotation created by first user, and a marking/annotation created by a second user is

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combined based on marking/annotation overlap), *said processor executing instructions including:*

- *Encompassing first content and an associated annotation in a first region* (column 9, lines 58-67: whereas, a first region, specified by start and end address/location information in a document is specified, which encompasses text content, and also the annotation (marking of type: highlighting (column 1, lines 29-34)).
- *Encompassing second content and an associated annotation in a second region*, as similarly explained above for the first region (column 9, lines 58-67). Furthermore, there can be more than one marking, as explained in column 5, lines 51-56: whereas, "markings", are disclosed, and thus makes possible for a second and/or plurality of regions to be implemented.
- *Combining the first region and the second region to form one of said clips, and an output for outputting said renderable image*: whereas, markings of a first region, indicated by a first color, is combined with markings of a second region of a second color, and the combination is stored (column 7, lines 55-67), such that the combined stored output is displayed as a renderable image through a viewer program (column 8, lines 14-28), where the renderable content is displayed through various methods including those explained in column 4, lines 43-63.

With regards to claim 24, which depends on claim 23, Madduri teaches *prior to combining, the processor executes instructions which determine that the first region and*

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the second region are within a threshold distance from each other in a document:

whereas, the first region, and the second region are determined to have a threshold distance be zero (In other words, the first and second region are determined to be overlapping), as explained in column 7, lines 55-65.

With regards to claim 5, which depends on claim 23, Madduri teaches *a storage storing said annotation, and an image of the content* (whereas, a marking file stores the annotation (column 2, lines 42-46), and the image of the document is stored in an electronic media file (column 2, lines 59-67)).

With regards to claim 6, which depends on claim 23, Madduri teaches *a storage storing said annotation*, as similarly explained in the rejection for claim 5, and is rejected under the same rationale. Furthermore Madduri teaches *a storage storing a link to said content* (column 6, lines 26-31: whereas, the markings file includes document identification information to identify/link the document to which the marking file applies). Additionally, Madduri teaches *wherein said documents are from different application programs* (column 5, lines 1-16: whereas, documents/electronic media are from different programs such as WordPerfect, and Microsoft Word).

With regards to claim 7, which depends on claim 23, Madduri teaches *a storage storing said annotation*, as similarly explained in the rejection for claim 5, and is rejected under the same rationale.

Furthermore, Madduri teaches *a storage storing active content* (column 4, lines 18-30: whereas, documents are actively transferred between computers on a network).

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Receiving a document, such as a video over the network, is a video stream, and thus demonstrates the storage of active content (column 5, lines 11-16).

With regards to claim 9, Madduri teaches

- *Receiving at least two sets of an annotation and related content:* whereas, a marking file can be created such that each marking file comes from a specific user (column 7, lines 4-17). Furthermore a first set of annotations by editor A (for which the annotations, and related content address data (addressing context) are stored in a marking file (column 5, lines 50-67), and a second set of annotations by editor B is received (column 7, lines 55-65).
- *Combining said at least two sets:* whereas, the at least two sets are combined, such that when one set of annotation data (of a first color), and the second set of annotation data (of a second color) overlap, a unique third color is produced (column 7, lines 55-65).
- *Filtering said combination of said at least two sets:* whereas, a user can view annotations by filtering the markings/annotations using a desired color (such as the third color mentioned above) (column 8, lines 14-28).
- *Displaying the filtered combination of said at least two sets:* whereas, the filtered combination, such as only viewing the combination based on the third color, is displayed for the two sets (column 8, lines 23-25).

With regards to claim 10, which depends on claim 9, Madduri teaches *storing said combination of said at least two sets* (column 7, lines 65-67, and column 8, lines 1-4: whereas, the combination of said at least two sets is stored)

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With regards to claim 13, Madduri teaches

- *Receiving data regarding an annotation*: column 7, lines 4-16: whereas, the data regarding the annotation is included in a marking file, to be sent/received by end users.
- *Storing link to context information with said annotation data in a storage*: (column 6, lines 26-31: whereas, the markings file includes marking/annotations and document identification information to identify/link the document to which the marking file applies).
- *Storing associations regarding at least two documents from which said annotation originates* (column 6, lines 26-31: whereas, the identification information includes identification information for document 10a, 10b, and 10c)
- *Wherein selection of said annotation accesses the at least two documents to display said annotations*: whereas, “upon selecting a marking file for a displayed document, to superimpose the markings on the text in the document 10a, 10b, and 10c” (column 6, lines 44-55), and since selecting an annotation to be viewed based on filtering includes selecting a marking file (column 8, lines 30-35) to access documents 10a, 10b, and 10c, then an annotation is selected and accesses at least two documents to display said annotations.

With regards to claim 15, for a computer readable medium performing a method similar to the method of claim 9, is rejected under the same rationale.

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With regards to claim 16, which depends on claim 15, for a computer readable medium performing a method similar to the method of claim 10, is rejected under the same rationale.

With regards to claim 19, for a computer readable medium performing a method similar to the method of claim 13, is rejected under the same rationale.

With regards to claim 25, which depends on claim 6, Madduri teaches *wherein said annotations are from different documents*, as similarly explained in the rejection for claim 13, and is rejected under the same rationale.

With regards to claim 26, which depends on claim 6, Madduri teaches *wherein said documents are from different application programs*, as similarly explained in the rejection for claim 6, and is rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Madduri (US Patent: 6,551,357 B1, issued: Apr. 22, 2003, filed: Feb. 12, 1999), in further view of Schilit et al (US Patent: US 6,279,014 B1, issued: Aug. 21, 2001, filed: Sep. 15, 1997). With regards to claim 2, which depends on claim 23, Madduri teaches *wherein said at least one of said clips*, as explained in the rejection for claim 23, and is rejected under the same rationale.

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However, Madduri does not expressly teach wherein said clips *includes additional content*.

Schilit et al teaches *clips containing additional content*: whereas each clip comprises a context portion (Schilit et al, column 6, lines 45-50), and addition content information, such as attributes concerning the type (column 7, lines 23-26), identified content (column 7, lines 27-30), or time/date data (column 7, lines 35-39).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Madduri's clips, such that they contain the additional information, as taught by Schilit et al. The combination would have allowed Madduri to have implemented "an annotation system for electronic documents ... with quick accessibility" (Schilit et al, column 3, lines 10-15)

8. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Madduri (US Patent: 6,551,357 B1, issued: Apr. 22, 2003, filed: Feb. 12, 1999), in further view of Wilcox et al (US Patent: 5,592,568, issued: Jan. 7, 1997, filed: Feb. 13, 1995).

With regards to claim 21, Madduri teaches:

- *An input for receiving annotations associated with content*, as similarly explained in the rejection for claim 23, and is rejected under the same rationale.
- *A processor for creating a renderable image having clips, wherein at least one of said clips is a combination of two or more annotations*, as similarly explained in the rejection for claim 23, an is rejected under the same rationale. *Said processor executing instructions including:*

- *Encompassing first content and an associated annotation in a first region, as similarly explained in the rejection for claim 23, and is rejected under the same rationale.*
- *Encompassing second content and an associated annotation in a second region, as similarly explained in the rejection for claim 23, and is rejected under the same rationale.*
- *Combining the first region and the second region to form one of said clips, and an output for outputting said renderable image, as similarly explained in the rejection for claim 23, and is rejected under the same rationale.*

Furthermore, Madduri teaches each region, is defined by a start and end address, and *bounds* or *boxes*/encloses-in, contextual content (such as a block of text indicated by a highlighting mark) related to the annotation (column 9, lines 49-67) and thus effectively creating a bounding address-box/region using addressing information. However, Madduri does not expressly teach the use of bounding boxes for the use of bounding image objects such as clippings.

Wilcox et al teaches implementing *bounding boxes* to enclose image objects of a recognized shape in a specific region (Abstract: whereas, bounding boxes enclose image objects based on markings/word shape). Additionally, Wilcox et al teaches combining bounding boxes should the threshold between their neighbors are within a threshold distance from each other in a document (column 19, lines 49-54).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Madduri's bounding address-regions, such that the regions,

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which comprise markings/annotations and context words, are bounded using the bounding boxes, as taught by Wilcox et al. The combination of Madduri and Wilcox et al would have allowed Madduri to have "recognized keywords (strings) without having to detect or recognize individual characters making up the strings" (Wilcox et al, column 1, lines 49-51: whereas, the characters indicated by the highlighted markings in Madduri, can be combined as a contiguous highlighted annotation selection)).

With regards to claim 22, which depends on claim 21, Madduri and Wilcox et al teaches *determin(ing) that the first bounding box and the second bounding box are within a threshold distance from each other in a document*, as similarly explained in the rejection for claim 21, and is rejected under the same rationale.

Response to Arguments

9. Applicant's arguments with respect to claims 2, 5-7, 9, 10, 13, 15, 16, and 19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wilson Tsui whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

W. T. 9/1/06

Wilson Tsui
Patent Examiner
Art Unit: 2178
September 1, 2006


STEPHEN HONG
SUPERVISORY PATENT EXAMINER